

### REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-17 were in the application, claims 1-17 have been cancelled, without prejudice, and new claims 18-32 have been substituted therefore.

The Examiner indicated that claims 1-20 were in the application, however, this was in error. This application was amended during the international phase, with the amendments transmitted by the International Bureau. In the amendment, the number of claims was reduced to 17. Also, a clean copy of the application was filed which contained the 17 claims from the amended drawing sheets.

The examiner objected to the drawings as failing to show the inner fan means and drawer. The applicant has cancelled the claims containing those elements, and the objection to the drawings has been rendered moot.

The objection to claim 5 as being in improper multiple dependant claim form is also moot in view of its' cancellation.

Claim 7 was rejected as being indefinite for use of the term "suitable", and this term is not found in any of the new claims and so this rejection is moot as well.

Claims 1-4, 6, 7 and 16 were ejected as being anticipated by Loof, DE 20014372.

The term "anticipation" in patent usage means that the invention was previously known to the public; that is, that it previously existed in the precise form in which it is claimed, including all of the limitations in the claim. SmithKline

Beecham Corp. v. Apotex Corp., 439 F.3d 1312, 1324 (Fed. Cir. 2006)

A claim cannot be "anticipated" by prior art that does not have all of the limitations in the claim. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000) *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1324 (Fed. Cir. 2006)

A finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device. *Shearing v. Iolab Corp.*, 975 F.2d 1541, 1544-45, 24 U.S.P.Q.2D (BNA) 1133, 1136 (Fed. Cir. 1992); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2D (BNA) 1913, 1920 (Fed. Cir 1989); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 U.S.P.Q. (BNA) 669, 673 (Fed. Cir. 1984). *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1349 (Fed. Cir., 1998)

New 18 contains as limitations the presence of a set of lights, as well as the aspirator means including a motorized fan (8) and filtering means (9), the motorized fan withdrawing the air and delivering the air to the filtering means for purifying the air, the filtering means having an upper portion which forms a second support (10) for the at least one limb portion.

Loof only shows what is in essence a carton, best seen in Fig. 2, that is assembled to surround a hand opening. As it has none of the elements referenced above, claims 1-4, 6, 7 and 16 and the claims depending therefrom are not anticipated thereby.

Claims 1, 2, 4, 6, 17 and 18 were rejected as being anticipated by Blackshear.

Blackshear discloses a large, fixed unit having a closed compartment, having seals through which an operator and a person can put their hands, so that the beauty treatment is performed within the enclosed space.

Of course this is much more cumbersome than the portable device of the applicants' invention which has no such enclosure. In particular, claim 18 requires a surface for supporting a limb portion, such as a hand, with the hand itself located on a second support which is an upper part of the filter element. Air is sucked through the filter by the fan and the purified air discharged through the base and back into the environment. By placing the limb portion on the filter, the suction is delivered precisely to the work area so dust, and fumes are captured before they can disperse, and so the operator and person are not exposed.

Each and every element of claim 18 is not found in Blackshear, arranged as in the applicants' invention, as no filter with a limb portion support is found in Blackshear, and so new claim 18 and the claims depending therefrom are not anticipated thereby.

Claims 1, 2, 6, 13, 18 and 19 were rejected as being anticipated by Rentz.

Rentz, similar to Blackshear utilizes a closed chamber where hands enter the chamber through sealed openings. Also as with Blackshear, there is no support formed by a filter element, such that the hands or feet are located on the filter when work is being performed. Note that an absorbent pad, placed in the closed chamber is

not a filter, and so this element is entirely absent from the device of Rentz.

As each and every element of claim 18 is not found in Rentz, arranged as in the applicants' invention, new claim 18 and the claims depending therefrom are not anticipated thereby.

Claims 8-12, 14, 15 and 20 were rejected as being obvious over Rentz in view of Park.

In order to uphold a finding of obviousness, there must be some teaching, suggestion or incentive for doing what the applicant has done. ACS Hospital Sys., Inc. v. Montefiori Hospital, 723 F.2d 1572 (Fed. Cir. 1984). Also, "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

The search for a teaching or suggestion should not be rigid, and a more flexible approach to a determination of obviousness should be used so as to avoid a conflict with common sense. KSR International Co. v. Teleflex Inc. et al, 127 S. Ct. 1727 (2007). In this decision, however, the Supreme Court reaffirmed that obviousness can not be established by a hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

As discussed above, Rentz discloses the use of a closed chamber with sealed openings as being necessary to capture fumes and particles that are liberated during a

manicurist treatment, which is contrary to the applicants' invention which achieves the same result but without having to look through a glass or plastic panel at the hands or feet. The applicants' invention is portable, compact, and allows complete freedom of access by the operator performing the manicure. Rentz fails to teach or suggest the device of the applicant where a filter provides a support such that suction is provided directly on the work area, and so no closed chamber is required to prevent fumes and particles from reaching the operator or the client receiving the treatment. Thus, even if the ultrasonic means of Park were incorporated with Rentz, this would be provided within the enclosed chamber, where no such filter resides, and so the new claims which incorporate the ultrasonic means are not rendered obvious by the proposed combination.

Based on the above amendment and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Coleman Sudol Sapone P.C.  
714 Colorado Avenue  
Bridgeport, CT 06605  
Telephone No. (203) 366-3560  
Facsimile No. (203) 335-6779

Respectfully submitted,  
/WJS/  
William J. Sapone  
Registration No. 32,518  
Attorney for Applicant(s)